



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,274	06/11/1999	LUIS VALENTE	LIBE0013	9225

7590 12/20/2002
GLENN PATENT GROUP
3475 Edison Way
Suite L
Menlo Park, CA 94025

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/330,274	Applicant(s) VALENTE, LUIS	
	Examiner Paul E. Callahan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 1999.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 December 1999 is: a) ☒ approved b) ☐ disapproved by the Examiner
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7-11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. 1-17 are pending in this application and have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the preamble language: "A method, including steps of..." The language is unclear since the preamble does not specify what type of method is being claimed. The Applicant is encouraged to change the preamble of the claim to something akin to: "A method for secure distribution of a digital certificate, the method including..." Claim 4 contains the language: "wherein said first certificate includes information authenticating a certificate from said first entity other than said first certificate." It is not clear what is meant by a certificate from said first entity other than said first certificate.

Claims 3-8 which are dependent on claims 1 and 4 are rejected on this basis as well.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2134

5. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 contains the language: "A article of manufacture including a computer data signal embodied in a memory medium, said readable medium including at least one of the following: a carrier wave, a memory, or a storage device. Electromagnetic signals embodied in a carrier wave or a memory medium do not represent patentable subject matter and the claim is rejected on this basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-11, and 13-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bruce Schneier, Applied Cryptography, Second Edition, John Wiley & Sons Pub., Oct. 1995, Section 8.12 Public-Key Key Management, Public key Certificates, and Section 24.9 ISO Authentication Framework, pp. 574-576.

As per claims 1 and 9, Schneier teaches A method, including steps of sending a first certificate from a first entity, said first certificate including security information regarding at least a second entity, said first certificate including information authenticating a second certificate from said second entity; and sending said second certificate from said second entity; whereby a recipient of said first certificate and said second certificate can authenticate from information therein a first set of security information to associate with said first entity and a

Art Unit: 2134

second set of security information to associate with said second entity, in figs. 24.2 and 24.3, and p. 575- 576 paragraphs 1-3.

As per claims 2 and 11, Schneier teaches the use of a root certificate in the first or second certificate in fig. 24.3 Certificates Cae, Cad, and p. 576 paragraphs 1-3.

As per claims 4 and 13, to the extent that the meaning of claim 4 can be discerned by the Examiner, Schneier teaches said first certificate includes information authenticating a certificate from said first entity other than said first certificate in fig. 24.3 item Cad and p.576 paragraph 1.

As per claims 5 and 14, Schneier teaches wherein said first certificate includes information authenticating a future intended version of said first certificate, in fig. 24.3 item Cae and p. 576 where the root certificate and certificates supplied to Alice and Bob are going to have the signature of the certification authority CA as will all future versions of certificates based upon any new public keys chosen by Alice and Bob.

As per claims 6 and 15, Schneier teaches said second certificate includes information authenticating a third certificate in fig. 24.3 Items Cad and Cab, and p. 576 paragraph 1.

As per claims 8 and 17, Schneier teaches wherein said security information includes a set of authorizations for said second entity, in page 574 fig. 24.2.

As per claims 10 and 16, Schneier teaches a second certificate indicating said second entity as its source; whereby a recipient of said first certificate and said second certificate can authenticate from information therein a first set of security information to associate with said first entity and a second set of security information to associate with said second entity, wherein said second certificate including security information regarding at least a third entity, said second certificate including information authenticating a third certificate from said third entity; and including steps of sending said third certificate from said third entity in figs. 24.2, 24.3 and p576 paragraphs 1-3 and p. 186 paragraph5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2134

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier as applied to claims 1 and 9 above, and further in view of Official notice as taken below.

Schneier teaches said first certificate including both an expiration date and information authenticating a third certificate in pages 574 fig 24.2, and page 186, however Schneier does not teach a third certificate including an expiration date other than an expiration date for said third certificate, however Official Notice may be taken that the use of such information in fields contained in x.509 certificates is old and well in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Schneier. It would have been desirable to do so as this would allow for greater security in the system by allowing a root certifying authority to more completely specify the expiration time frame of certificates.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone numbers for the

Application/Control Number: 09/330,274

Page 6

Art Unit: 2134

organization where this application or proceeding is assigned are (703) 746-7239 Official Faxes, (703) 746-7240 Unofficial Faxes, and (703) 746-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

12/14/02

Paul Callahan

GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100